

Appl. No. 09/663,576  
Atty. Docket No. 7882X  
Amdt. dated January 16, 2004  
Reply to Office Action of October 16, 2003  
Customer No. 27752

### REMARKS

Claims 1-15 and 34 are pending in the present application. No additional claims fee is believed to be due.

Claims 16-31 have been withdrawn.

Claims 32, 33, and 35 are canceled, without prejudice, due to the fact that Claims 32, 33, and 35, while indicated by the Examiner as being part of Group I, are dependent upon withdrawn Group II claims. To expedite prosecution of this case, these claims have been canceled without prejudice.

Claims 1, 8, 9, 12, 13, 14, 15, and 34 have been amended to more specifically characterize the claimed ether-capped poly(oxyalkylated) alcohol of the present invention. It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

The Office Action recommends formally canceling Claims 16-31 rather than indicating that such claims are withdrawn. Applicants submit that Applicants selected Class I including Claim 1-15 and 32-35 in response to an election/restriction requirement dated December 10, 2002. Unelected Claims by the Applicant included Class II, Claims 16-22 and Class III, Claims 23-31. According to 37 CFR § 1.121, unelected claims must be indicated as "withdrawn" and the text of a withdrawn claim must be presented. As such, Applicant must present Claims 16-31 as withdrawn according to 37 CFR § 1.121.

Applicants thank the Examiner for the withdrawal of the objection to Claims 8-10

#### Rejection Under 35 USC 112, First Paragraph

Applicants thank the Examiner for the withdrawal of the rejection of Claims 9-10 under 35 U.S.C. § 112, first paragraph.

#### Rejection Under 35 USC 112, Second Paragraph

Applicants thank the Examiner for the withdrawal of the rejection of Claims 9-10 under 35 U.S.C. § 112, second paragraph.

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Rejection Under 35 USC 102 & 103 Over GB 2,158,080 A, Hatton, et al.

Applicants thank the Examiner for the withdrawal of the rejection of Claims 1-3, 13-15 and 32-35 under 35 U.S.C. § 102(b) in view of Hatton et al.

Rejection Under 35 USC 103(a) Over DE 2,556,544, Billenstein, et al.

Applicants thank the Examiner for the withdrawal of the rejection of Claims 1-3, 13-15 and 32-35 under 35 U.S.C. § 102(b) in view of Billenstein et al.

New Matter Objection

The Office Action has objected to the amendment under 35 U.S.C. § 132 for introduction of new matter. Specifically amendments made to Claim 1(ii)(b)-(ii)(d) and (iv)(b)-(iv)(c) for the variable  $R^2$ .

Applicants have made appropriate amendments to Claim 1(ii)(b)-(ii)(d) and (iv)(b)-(iv)(c) and support for the amendments are found in the specification as follows:

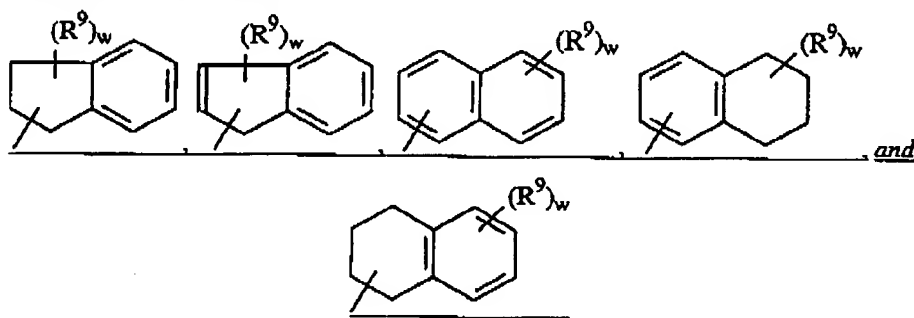
(ii)(B) a 4, 5, 7 or 8 membered substituted or unsubstituted aromatic hydrocarbon radical

Support is found in the specification at page 8, lines 7-16.

(ii)(C) a 6 membered aromatic hydrocarbon radical wherein R is a linear or branched saturated or unsaturated,  $C_9$  to  $C_{20}$  aliphatic hydrocarbon radical

Support is found in the specification at page 8, lines 7-16 and page 4, lines 1-4.

(ii)(D) selected from the group consisting of:



wherein each  $R^9$  is independently selected from the group consisting of hydrogen, linear or branched, saturated or unsaturated, substituted or unsubstituted, aliphatic hydrocarbon or alkoxy radical having from about 1 to about 10 carbon atoms, a saturated or unsaturated, substituted or unsubstituted, alicyclic or aromatic hydrocarbon radical having, from about 3 to about 10 carbon atoms, which is fused to the ring; w is an integer from 1 to 3

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Support is found in the specification at page 8, line 17-page 9, line 4.

(iv) (B) methyl, wherein R is branched saturated or unsaturated, aliphatic hydrocarbon radical having from 1 to 4 carbon atoms

Support is found in the specification at page 4, lines 17-23.

(iv) (C) a substituted or unsubstituted aromatic hydrocarbon radical having from about 15 to about 30 carbon atoms

Support is found in the specification at page 4, lines 17-23.

#### Rejection Under 35 U.S.C. §112, First Paragraph

The Office Action States Claims 1-15 and 34 are rejected under 35 U.S.C. §112, First Paragraph as failing to comply with the written description requirement. Specifically, Claim 1(ii)(b)-(ii)(d) and (iv)(b)-(iv)(c) for the variable R<sup>2</sup>. Additionally the Office Action States that the newly added limitation in Claims 12-14 are also unsupported.

An applicant's specification must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, i.e., whatever is now claimed. Vas-Cath, Inc. v. Mahurkar, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." Ralston Purina Co. v. Far-Mar-Co., Inc., 227 USPQ 177, 179 (Fed. Cir. 1985). The subject matter of the claim need not be described literally (i.e., using the same terms or in *haec verba*) in order for the disclosure to satisfy the description requirement. See MPEP §2163.02. The inquiry into whether the description requirement is met must be determined on a case-by-case basis and is a question of fact. In re Wertheim, 191 USPQ 90, 96 (CCPA 1976). The examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. In re Wertheim, 191 USPQ at 98.

Applicants submit that the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, what was in possession of the invention, i.e., whatever is now claimed. In the decision of Ex parte Sorenson, 3 USPQ2d 1462 (Bd. Pat. App. & Inter. 1987), it was decided that the subgeneric language of "aliphatic carboxylic acid" and "aryl carboxylic acid" did not violate the written description requirement because species falling within each subgenus were disclosed as well as the generic carboxylic acid. Similarly, Applicants submit that the narrowing of Claim 1 for the claim of the R<sup>2</sup> moiety from:

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(iii) a hydrocarbon of the formula:



wherein, y is an integer from 1 to 7, X is a 4 to 8 membered substituted, or unsubstituted, partially unsaturated cyclic or aromatic hydrocarbon radical; and

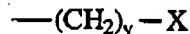
(iv) a hydrocarbon radical of the formula:



wherein  $R^3$  is selected from the group consisting of linear or branched, saturated or unsaturated, substituted or unsubstituted, aliphatic or aromatic hydrocarbon radicals having from about 1 to about 30 carbon atoms, provided that when  $R^3$  is methyl, R is branched;

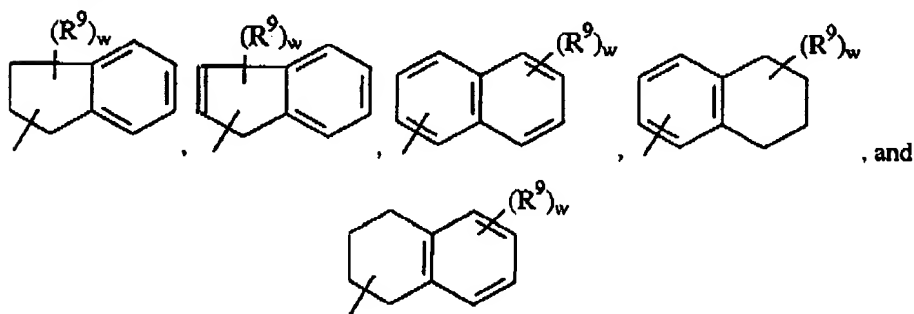
to claim the subgeneric language of:

(iii) a hydrocarbon of the formula:



wherein, y is an integer from 1 to 7, X is selected from the group consisting of:

- (A) a 4 to 8 membered substituted, or unsubstituted, partially unsaturated cyclic hydrocarbon radical;
- (B) a 4, 5, 7 or 8 membered substituted or unsubstituted aromatic hydrocarbon radical;
- (C) a 6 membered aromatic hydrocarbon radical wherein R is a linear or branched saturated or unsaturated,  $C_9$  to  $C_{20}$  aliphatic hydrocarbon radical;
- (D) selected from the group consisting of:



wherein each  $R^9$  is independently selected from the group consisting of hydrogen, linear or branched, saturated or unsaturated, substituted or unsubstituted, aliphatic hydrocarbon or alkoxy radical having from about 1 to about 10 carbon atoms, a saturated or unsaturated, substituted or unsubstituted, alicyclic or aromatic hydrocarbon radical having, from about 3 to about 10 carbon atoms, which is fused to the ring; w is an integer from 1 to 3.

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Such that the subspecies of (iii) and (iv) are within the generic description of original subgroup (iii) and (iv) and original R moiety definition. With respect to changing numerical range limitations, the analysis must take into account which ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure. Applicants submit that the numerical range limitations are ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure. Therefore, Applicants submit that the Examiner has failed to present a prima facie case for failing to comply with the written description requirement.

Applicants further submit that Claims 13 and 14 likewise contain subgeneric language of the original generic subgroup. Applicants submit that the amendments, being supported by the specification, would have been conveyed with reasonable clarity to those skilled in the art that, as of the filing date sought, what was in possession of the invention, i.e., what is now claimed.

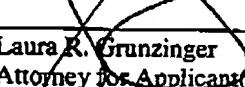
#### Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. §§ 112, first paragraph. Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1-15 and 34. If, prior to allowance, any outstanding issues exist, Applicants' attorney would welcome the opportunity to resolve such issues via a phone interview.

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Respectfully submitted,  
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